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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,757	10/13/2000	Chul-woo Lee	030681-032	8067

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EXAMINER

STAFIRA, MICHAEL PATRICK

ART UNIT PAPER NUMBER

2877

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/689,757

Applicant(s)

LEE ET AL.

Examiner

Michael P. Stafira

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 is/are allowed.
- 6) ☒ Claim(s) 27-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/640,474, filed on 05/01/1996.

Reissue Applications

The amendment filed March 26, 2003 fails to comply with the required format required by 37 CFR 1.173(b). The amendment fails to underline the new material a mark-up copy does not comply under 37 CFR 1.173(b). See paragraph below:

Making amendments in a reissue application. An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used.

If amendment is made by an amendment paper, the paper must direct that specified changes be made.

Changes shown by markings. Any changes relative to the patent being reissued, which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

- (1) The matter to be omitted by reissue must be enclosed in brackets; and
- (2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter

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added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

35 U.S.C. 251 Rejection

1. Claims 27-40 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

A review of the prosecution of application No. 08/640,474, which matured into US Patent No. 5,822,135, reveals that, in response to the Office rejection of claims 1-3, 11, 13-15, 17-19 and 23 under 35 USC 102(e) as being anticipated by Okamoto (US patent 5,502,001) of June 24, 1997, applicant amended claim 1 by adding to the recitation "said light controlling means permitting light in said near and far regions of said light path to reach said focal zone" the limitation "**without imposing a relative phase change between light in said near and far regions**" and argues that "As expressly disclosed throughout the application, the present invention is a lens device including a lens for focusing light into a focal zone and having a predetermine effect diameter. The lens device includes a light controlling means provided in the light path of the lens for preventing light in an intermediate axial region of the light path from reaching the focal zone ... A light controlling means permits light and the near and far regions of the light path to reach the focal zone **without phase shift relative to one another**. (Emphasis original) See Response filed 10/14/97, paragraph bridging pages 6 and 7. It is further stated on

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page 7, 2nd full paragraph, that "Applicant has discovered a mechanism wherein the phase-shifting technology is not necessary to the operation, which leads to a simpler design and reduce overall expense conforming the lens device." For this reason, applicant urged that the rejection based on 35 USC 102(e) be withdrawn since the combination of the features found in the claims are not anticipated by the Okamoto patent.

----- A review of the newly submitted claims 27-40 reveals that none of the independent claims 27,30,32 and 37 recites a light controlling means that permits light in the near and the far regions of the light path to reach the focal zone **without imposing a relative phase change of shift between the light in the near and far regions** as set forth in patent claim 1, the only independent claim in the patent. Thus, the newly presented independent claims 27,30,32 and 37 are broader than the patent claim 1 in the aspect of not having phase change or shift between the light in the near and far regions.

It is clear from the prosecution record of the patent that claim 1 was amended by adding the limitations "without imposing a relative phase change..." to overcome the rejection of claim 1 under 35 USC 102(e) over the Okamoto patent. Furthermore, it is argued that the prior art required a phase shift while, in applicants invention, the phase shifting technology was not necessary. By amending the claims to exclude the phase change/shift and arguing that such feature defined applicant's invention has been surrendered to the public. Thus, by not including the recitation of the controlling means that permits light to reach the focal zone without imposing a relative phase change between the light in the near and far region in new independent claims 27,30,32, and 37, applicant is attempting to recapture subject matter that has been surrendered during the original prosecution of the patent.

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From the above analysis, the applicant has specifically limited the claim to exclude phase changing of the light to obtain the patent. On reissue, applicant is stopped from attempting to recapture this precise feature that is added and argued to overcome the prior art rejection over the Okamoto patent. Therefore a case of recapture is made for claims 27-40 under 35 USC 251 which applicant must address before the reissue application may be allowed.

Response to Arguments

2. Applicant's arguments filed March 26, 2003 have been fully considered but they are not persuasive.

In applicant's Amendment dated March 26, 2003 applicant argues the recapture of claims 27-40 on pages 3-5 and cites case law B. E. Meyers & CO. v. United States wherein applicant admits that there are "separate inventions eligible for patent protection".

Examiner argues that the applicant cannot receive a patent on an invention wherein the applicant surrenders the claimed limitations in the parent to overcome the prior art. Applicant claimed AB in the parent and amended the claims to receive a patent on AB_{sp}, and now in the reissue application is claiming A. The surrendered limitation argued in the parent case and amended is B_{sp}, which therefore needs to be present in the claim limitations to avoid recapture issues.

The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997). Reissue claims that are broader than the original patent's

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claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible.

The application of the recapture rule is a three-step process:

The first is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims.

The second step is to determine whether the broader aspects of the reissued claim are related to surrendered subject matter.

Finally, the court must determine whether the reissue claims were materially narrowed in other respects to avoid the recapture rule. *Hester Industries Inc. V. Stein Inc.*, 46 USPQ2d 1641 (Fed. Cir. 1998); *Clement* at 1165.

Therefore, the rejection of claims 27-40 under 35 USC 251 stands in view of applicant arguments.

Allowable Subject Matter

1. Claims 1-26 are allowed over the prior art of record.
2. The following is an examiner's statement of reasons for allowance:

Regarding claim 1, the prior art fails to disclose or make obvious a lens device having the light controlling means permitting light in the near and far regions of the light path to reach the focal zone without imposing a relative phase change between light in the near and far regions, and in combination with the other recited limitations of claim 1. Claims 2-26 are allowed by the virtue of dependency on the allowed claim 1.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

-----A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Stafira whose telephone number is 703-308-4837. The examiner can normally be reached on 4/10.

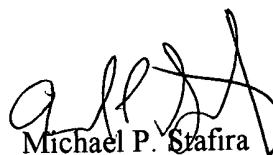
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 703-308-4881. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

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A handwritten signature in black ink, appearing to read 'M. Stafira', is written over the printed name.

Michael P. Stafira
Primary Examiner
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June 30, 2003
